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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/187,332	11/06/1998	JOE G. NAYLOR	JFX/027-98	2923

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EXAMINER
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HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 04/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/187,332

Applicant(s)  
Naylor et al.

Examiner  
Robert B. Harrell

Art Unit  
2152



- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 1/28/02

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 19-36 is/are pending in the applica

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from considera

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 19-36 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirem

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☒ Other: office action.

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1. Claims 19-36 remain for examination.
2. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:
  - a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103.
4. Claims 19-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (5,805,298) alone or in view of Fabbio et al. (5,870,089).
5. Per claim 19, Ho taught the invention substantially as claimed, including a method comprising:
  - a) receiving from a user a facsimile telephone number or an electronic mail address of the same recipient, and storing the number and address in a memory of a facsimile machine (eg., see col. 6 (lines 31-48));

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- b) converting a document provided by the user to the facsimile machine into digital form (eg., see col. 4 (lines 10-22) and col. 7 (lines 31-53));
- c) associating an actuator disposed on the facsimile machine to locations in the memory which contain the facsimile telephone number and the electronic mail address (eg., see figures 2 and 3, col. 5 (line 40-et seq.), and col. 6 (line 23-et seq.)); and,
- d) transmitting the converted document to the facsimile telephone number or to the electronic mail address in response to the actuator being activated by the user (eg., see col. 6 (lines 27) to col. 7 (line 17)).

6. While Ho did not specifically send the message via both by facsimile and e-mail "at the same time", such would have been obvious to those skilled in the art when taken Ho alone. That is, the message could first be sent by e-mail and then latter by facsimile or at the same time. Furthermore, on line 2 of Ho's abstract, in col. 1 (lines 46-53), and in col. 2 (lines 19-22) Ho suggested transmitting in both facsimile "and" electron mail. Since his device could do both, doing both at different times or at the same time would have been obvious to those skilled in the art. Also, sending the message by facsimile and e-mail would have been obvious to those skilled in the art when taking Ho in view

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of Fabbio who taught of sending electronic mail and facsimile (eg., see Fabbio in col. 3 (lines 4-23 "at the same time" on line 22)) at the same time. In fact, not only was the facsimile sent at the same time with the e-mail, they each were sent at the same time to a printer (eg., see col. 3 (lines 4-23)).

7. It would have been obvious to have combined these references because they were both directed to sending electronic mail and facsimile to a recipient from a single device. Furthermore, col. 6 (lines 32-36) of Fabbio stated that the delivery service system 12 of figure 2 could be either a stand alone computer or a local area network (LAN) as called for by Ho in col. 3 (line 54) to col. 4 (line 6). Since Ho called for a LAN version, and Fabbio taught a LAN version, it would have been obvious to those skilled in the art to use Fabbio's system in Ho's system (specifically delivery server 12 of Fabbio's second figure for the PSIN 106 in Ho's first figure).

8. Per claim 20, Ho taught that his actuator was a button (eg., see figure 2(a)) which then transmitted the converted document once being pressed by a user (eg., see col. 6 (line 27) to col. 7 (line 17)).

9. Per claims 21,22, and 26 Ho taught that electronic mail was sent via a server (SLIP/PPP (ie., an Internet Service Provider

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over a packet switched data network (eg., see col. 4 (lines 1-6 "LAN" Local Area Network which is a packet switched data network))) and facsimile was sent to the recipient via a PSTN 106 in figure 1 and col. 3 (lines 32-43). A PSTN is a Public Switch Telephone Network having several computers. Also, Fabbio taught that the delivery server 12 (of figure 2) was a server (eg., see col. 6 (line 25-et seq.)).

10. Per claims 23-25, such is standard facsimile operations and was taught in Ho at col. 3 (lines 27-32) and 6 (line 27-et seq.)) in that a document was scanned and appropriate facsimile information (ie., a cover sheet having the senders information, the recipient information, exc...) with the document parsed to ascertain where to send the document (eg., see col. 4 (line 23-et seq.)), or in Fabbio (eg., see col. 6 (line 43-et seq.)). Since Optical Character Recognition is well known in the art, the scanner obviously could have been an alternative means of inputting such information rather than by use of a keyboard.

11. In conclusion, Ho taught the invention as claimed except for send both the fax and e-mail "at the same time". But since Ho could either fax or e-mail one or the other, Ho had the means for sending them at the same time when taking Ho alone; or, in light of Fabbio, sending a fax and an e-mail at the same time in Ho

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would have been obvious to those skilled in the art.

12. Per claims 27-36, these claims do not teach or define the above cited claims and thus are rejected for the reasons outline above (eg., see col. 3 (line 29 for claim 29's BFT)).

13. Per the applicant's remarks filed 1/28/02 (paper #17), the applicant argued in substance that:

- a) neither Ho by itself or in combination with Fabbio teaches or suggest sending to a facsimile telephone number and to an electronic mail address, in response to the same instance of the actuator being activated by the user. However, Ho clearly taught of sending to either the facsimile telephone number or to an electronic mail address. Since the communication channels were both available, transmitting a document at the same time would have been obvious to those skilled in the art. Furthermore, Fabbio clearly taught that a document could be sent not only to a printer, but to a facsimile telephone number and to an electronic mail address all at the same time. Thus in light of Fabbio, it would have been obvious to those skilled in the art to modify and take advantage of the communication channels such that the document was sent to a facsimile telephone number and to an electronic mail address all at the same time;
- b) Ho does not teach or suggest receiving from the user a

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facsimile telephone number and an electronic mail address of the same recipient, and transmitting a converted document to both the facsimile telephone number and the electronic mail address in response to the same instance of an actuator being activated by the user. However, as indicated above, sending a document to both locations would have been obvious when taking Ho alone since the means were there, or when viewing the teaching of Fabbio which permitted a document to be sent to several locations at the same time. Thus, it would have been inherently required to enter all information prior to activating the actuator such that the document is sent to all locations at the same time;

c) while concerned with improving the value of a fax machine as a stand alone, document transmission device, would not look to learn from the general purpose computer software system of Fabbio. However, one viewing Ho would obviously have noticed that both fax and e-mail could be sent "at the same time" and with the knowledge of Fabbio, those skilled in the art knew that fax and e-mail had been sent to the same location "at the same time" and thus would have been motivated to have modified Ho such that Ho's system could send fax and e-mail at the same time;

d) there is no suggestion that the destination identifiers in Fabbio are of the same recipient. However, to whom documents are



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sent are clearly a selection of the user. The user obviously could have sent the documents to the same person or different people.

14. For all the reasons given above, sending facsimile messages and e-mail messages in Ho over the two lines at the same time would have been obvious to those skilled in the art when viewing Ho alone, or more specifically, clearly obvious while viewing Ho in light of Fabbio. Also, those skilled in the art would have clearly noticed that while the PSTN (106 of figure 1) was used for transmitting a facsimile message, the SLIP/PPP would stand idle and thus one would have been motivated to use that line at the same time for sending e-mail while the facsimile was being sent. Additional usage of the SLIP/PPP would not destroy the sending of the facsimile message while the e-mail message was being sent at the same time. When reviewing Fabbio (figure 7 (146)) with respect to Ho, one would have understood the obvious need to enter more than one destination. Finally, the claims fail to provide any temporal order as to when the messages are transmitted, they could be at the exact same moment or at different points in time.

15. In conclusion, since Ho could send a Fax or an e-mail, it would have been obvious to have modified Ho to do both at the

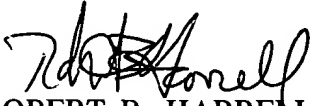
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same time.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for the Group is (703) 308-7201.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

  
ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2152